

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the present Amendment, Claims 18-19 and 21-25 will be all the claims currently pending. Instantly, Claim 18 is amended and Claim 20 is canceled. Applicants respectfully submit no new matter has been added by the present amendment. Support for the amendment can be found generally throughout the disclosure. It should be noted this amendment is not in acquiescence of the Office's position on the allowability of the claims, but merely to expedite prosecution.

The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

I. CLAIM REJECTIONS:

A. 35 USC 112, First Paragraph

Claims 18-25 stand rejected under 35 U.S.C. §112, first paragraph, written description requirement. The Office opines there to be a lack of possession of the claimed invention, namely, the method steps. Applicants disagree for the reasons to follow and ask for the Examiner's reconsideration.

By providing discussion of a method of injection in which a hole is drilled in a tree, Applicants have demonstrated their possession of the claimed method of injection regardless of whether the hole is below the felling site. As provided in Applicants' Examples there is made reference to the injection at a particular distance above ground. (Page 8, Lines 20-22) As such, it is clear Applicants have met their written description requirements as discussed above and ask the rejections now be withdrawn.

While the failure to claim an essential feature does not comply with the written description requirement (see, MPEP 2163.05), Applicants have not characterized the

location as being essential/critical. As provided by the court in *In re Edwards*, "[i]t is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him." *Id.*, 568 F.2d at 1351-52, 196 U.S.P.Q. at 467 (citations omitted).

Regarding Examiner's rejection related to the manner of drying, the claims as presently amended now provide for air drying. Since such drying is fully supported in the specification as filed, the rejections should now be withdrawn as well.

B. 35 USC 103

i. Grosman et al.

Claims 18, 20, 21, 24, and 25 are rejected under 35 U.S.C. § 103 as obvious over Grosman et al., *Southern Journal of Applied Forestry*, 2000 (hereinafter "Grosman").

As best understood, Grosman relates to a process for protecting trees against cone worm and seed bug damage in loblolly pine seed orchards, wherein an insecticide is injected into a living tree by means of high volume pressure injections. The use of thiamethoxam in low volume injections is mentioned. At minimum, Grosman fails to teach or suggest the tree injection for post felling lumber product protection as noted by the Office. Furthermore, Grosman fails to teach or suggest the use of a surfactant and is silent regarding types of solvents used in the insecticide solution.

The Office opines that a) Grosman's trees would have been harvested for lumber and b) allowing the trees to dry would have been obvious so as to be used for lumber. Applicants disagree.

Firstly, the Office indicates the trees as discussed in Grosman would be harvested to produce lumber. This is mere speculation without support. Grosman itself deals with the prevention of coneworm and seed bug damage to living trees as

evidenced in the title and discussion of such insects starting on page 149. It is clear that Grosman relates to the protection of living trees *per se*.

Secondly, the Office's allegation of obviousness regarding drying for lumber purposes is predicated on the assumption that Grosman discloses the use of its trees as lumber products. Again the same without supporting evidence is mere speculation.

Since it is clear that Grosman taken as a whole fails to suggest the use of its trees for lumber product, the rationale as provided by the office fails to establish a *prima facie* case of obviousness and should therefore be withdrawn.

ii. Takai et al., Kim et al., Derwent and Senn

Claims 18-25 are rejected under 35 U.S.C. § 103 as obvious over Takai et al., JP 8175914 (hereinafter "Takai"), in view of Kim et al., Abstract of Journal of Korean For. Soc. (hereinafter "Kim"), Derwent Abstract of Forestry Mech. Res. Inst. (hereinafter "Derwent Abstract"), and Senn, US Pat. Pub. No. 2003/0181448 (hereinafter "Senn").

Similarly to the above as applied to Grosman, the Office simply states that while Takai fails to suggest the use of the trees as lumber, such use would occur. Again, there is no evidence for such a conclusion. As best understood, Takai relates to the injection of a living tree with a solublized formulation comprising an insecticide or germicide, solvent miscible with water, and a surfactant. Takai fails to teach or suggest the tree injection for post felling lumber product protection. Furthermore, Takai appears to also fail to teach or suggest the use of the present neonicotinoids, for example, thiamethoxam. Kim, Derwent, and Senn fail to overcome these deficiencies of Takai.

As best understood, Kim relates to the injection of a living tree with insecticides, including imidacloprid and thiamethoxam. At minimum, Kim fails to teach or suggest the tree injection for post felling lumber product protection. Furthermore, Kim appears to also fail to teach or suggest the use of a surfactant and is silent regarding types of solvents used in the insecticide solution.

As best understood, Derwent relates to the injection of a living tree with insecticides prior to felling or immediately after felling to increase quality of wood during storage and transport. At minimum, Derwent Abstract fails to teach or suggest the use of the present neonicotinoids, for example, thiamethoxam and while disclosing tree storage and transport, Derwent Abstract is silent regarding tree injection for post felling lumber product protection. Furthermore, Derwent Abstract appears to also fail to teach or suggest the use of a surfactant and is silent regarding types of solvents used in the insecticide solution.

As best understood, Senn relates to a method for the control of wood pests via application of a pesticidally active amount of a pesticidal composition to the pests or their habitat. Said pesticidal composition comprises thiamethoxam either alone, or in combination with a surfactant and a solvent. At minimum, Senn fails to teach or suggest any type of tree injection, especially tree injection for post felling lumber product protection.

For the aforementioned reasons, the rejections should be withdrawn at this juncture.

ii. Takai et al., Kim et al., Uto and Senn

Claims 18-25 are rejected under 35 U.S.C. § 103 as obvious over Takai, Kim, Abstract of WO 2004/108372, (hereinafter "Uto"), and Senn.

The instant rejection is substantially the same as (i) above, but Derwent is replaced with Uto. As best understood, Uto relates to a method for producing functional wood, wherein an insecticide is injected into a living tree prior to it being cut down and formed into a functional wood. At minimum, the Uto Abstract is silent regarding type of insecticide, whether there is a solvent and surfactant and/or types thereof.

In any event, as Examiner rightly noted, Uto can be overcome with Applicants' perfection of its priority claim via submission of certified translation of the priority

document. Applicants are filing herewith a certified translation of the priority document and thereby perfect their priority claim.

In light of the above, the rejections should be withdrawn.

C. Obvious Type Double Patenting Rejections

Claims 1-17 were previously provisionally rejected based on an obvious type double patenting over Claims 1, 5, 7-10 of co-pending application no. 10/598,616, in further view of allegedly acknowledged prior art and the Derwent Abstract and Senn.

Examiner has maintained the rejection and requests citation for the proposition regarding the inappropriateness in combining claims and references to make an obvious-type double patenting rejection. Without reaching the nature of what is taught by the proposed combinations, upon further review, the undersigned acknowledges the case law allowing for such a combination of claims and references. *E.g. Ex Parte Frank Schmit*, 64 USPQ2d 1723 (2000).

Since the instantly amended claims have not yet been considered and since there is no subject matter in the presently claimed application which has, except for the obvious-type double patenting rejections, been found otherwise allowable, it is unclear whether such subject matter will still be considered to result in an obvious-type double patenting rejection when allowed; therefore, the filing of a terminal disclaimer, by Applicants in this regard would be premature.

Applicants hereby reserve their right to respond to said rejections, if necessary, at such time as they are the only remaining rejections.

II. CONCLUSION

In view of the foregoing, it is respectfully submitted that Claims 18-19 and 21-25 are fully distinguishable over the applied art and are thus in condition for allowance. Notice to the effect is earnestly solicited.

If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 CFR 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

By: _____



Nicanor A. Kohncke
Attorney for Applicants
Reg. No. 57,348

LANXESS CORPORATION
Law & Intellectual Property Department
111 RIDC Park West Drive
Pittsburgh, Pennsylvania 15275-1112
PHONE: (412) 809-2234
FACSIMILE: (412) 809-1054

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APPENDIX A